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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,679	08/01/2001	Juliana H.J. Brooks	BLP:101 (a) US-CIP	6650

7590 07/17/2008
The Law Offices of Mark G. Mortenson
Post Office Box 310
North East, MD 21901-0310

EXAMINER

HANLEY, SUSAN MARIE

ART UNIT	PAPER NUMBER
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1651

MAIL DATE	DELIVERY MODE
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07/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/919,679	Applicant(s) BROOKS ET AL.	
	Examiner SUSAN HANLEY	Art Unit 1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendment and remarks filed 6/12/08 have been entered.

Claims 1-15 are pending.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

New Grounds of Rejection Based on the Amendment

Claim Rejections - 35 USC § 112

Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1 and 13 have been amended to recite the limitation: wherein said chemical reaction is catalyzed by a physical catalyst which does not require the addition of radiant or light energy to function as a catalyst in the chemical reaction system. This newly added limitation constitutes NEW MATTER because the concept is not disclosed in the specification as-filed. The specification discloses as page 4, the definition of a catalyst. However, there is not mention of a negative limitation regarding the addition of radiant or light energy.

Regarding negative limitations, the MPEP, 2173.05(j) states:

Any negative limitation or exclusionary proviso must have basis in the original disclosure.

If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the

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part remaining.”). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff’d* mem., 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph.

The instant specification provides no basis for exclusionary disclosure regarding physical catalysts. Hence, it is clear that applicant was not in possession of the full scope of the claimed subject matter at the time of filing.

The following rejections are withdrawn pending the result of the New Matter rejection *supra*.

Claims 1-4, 7-9 and 13 stand rejected under 35 U.S.C. 102(b) as being clearly anticipated by Tsutsui et al. (US 4,287,036; “Tsutsui”).

Claims 1-4 and 7-13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Lichtin et al. (US 4,861,484) in view of Tsutsui et al. (US 4,287,036; “Tsutsui”).

Claims 1, 3, 4, 7, 8 and 10-14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Pratt, Jr. (US 4,115,280; “Pratt”) in view of Vladimirov (1988, abstract only) and Cronheim (1937; abstract only).

Claims 11 and 15 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1-6, 9, 10 and 12-14 stand rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method for augmenting a physical catalyst that catalyzes the conversion of a reactant to a product, by the steps of a)-c) of claim 1 wherein the determined frequency is at least a duplicated frequency of the EM spectral pattern or a harmonic frequency of the duplicated EM spectral pattern and the physical catalyst is present in the chemical reaction system at the time of exposure to said frequency, does not reasonably provide enablement for a method for augmenting a physical catalyst that catalyzes the conversion of a reactant to a product, by the steps of a)-c) of claim 1 wherein the determined frequency can also be at least one frequency which copies at least one mechanism of said at least physical catalyst (part iii of claim 13); or the chemical reaction system is irradiated prior to the addition of the physical catalyst (as in claim 11).

Claims 13 and 15 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-4, 7-9 and 13 stand rejected under 35 U.S.C. 102(b) as being clearly anticipated by Borsub et al. (1984).

Claims 1, 3-8 and 10-14 stand rejected under 35 U.S.C. 102(b) as being clearly anticipated by Biscar et al. (1975).

Claims 1, 2, 3, 4, 9 and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mohr (US 6,217,712, based on the parent application 08/760,342) in view of website of the National High Magnetic Field Laboratory (downloaded 12/22/06).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUSAN HANLEY whose telephone number is (571)272-2508. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susan Hanley/
Examiner, Art Unit 1651

/Sandra Saucier/
Primary Examiner, Art Unit 1651

Search Notes (continued)

Application/Control No.

09/919,679

Examiner

SUSAN HANLEY

Applicant(s)/Patent under
Reexamination

BROOKS ET AL.

Art Unit

1651

SEARCHED

Class	Subclass	Date	Examiner

INTERFERENCE SEARCHED

Class	Subclass	Date	Examiner

**SEARCH NOTES
(INCLUDING SEARCH STRATEGY)**

	DATE	EXMR
WEST: UPDATED	10/1/2007	SMH
WEST: UPDATED	7/16/2008	SMH